

REMARKS

Applicants hereby add new claims 51-57. Accordingly, claims 1-42, 46, and 49-57 are pending in the present application.

Claims 1-3, 6-8, 11-13, 16-22, 24, 27-29, 33-37, and 41-42 stand rejected under 35 U.S.C. §103(a) for obviousness over U.S. Patent No. 5,842,118 to Wood, Jr. in view of U.S. Patent No. 5,649,296 to MacLellan et al. and U.S. Patent No. 3,733,602 to Cuckler et al. Claims 9-10 and 49-50 stand rejected under 35 U.S.C. §103(a) for obviousness over Wood in view of MacLellan and Cuckler and further in view of U.S. Patent No. 6,353,729 to Bassirat. Claims 4-5, 14-15, 23, 26, 30-32, 38-40, and 46 stand rejected under 35 U.S.C. §103(a) for obviousness over Wood in view of MacLellan and Cuckler and further in view of U.S. Patent No. 5,799,010 to Lomp.

// Claim 1 stands rejected over numerous prior art references in a 103 rejection. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, e.g., M.P.E.P. §2143 (8th ed.).

The Examiner relies upon teachings of Wood and teachings of MacLellan as allegedly disclosing limitations of claim 1. It is stated on page 6 of the Action that MacLellan discloses a communication station remotely located with respect to a housing to extend a range of communication with a tag or transponder and it is proper to combine

MacLellan with Wood because MacLellan teaches a communication station to communicate the remote device to extend the range of communication. Applicants disagree.

Fig 1 MacLellan is devoid of any communication station remotely located with respect to a housing to extend the range of communication with the tag or transponder and the Office Action fails to identify any teachings which allegedly support the range extending assertion. Applicants have also electronically searched MacLellan and have failed to locate any teachings which support the Examiner's range extending allegations. Accordingly, the prior art is devoid of the alleged motivational rationale relied upon to support the combination of reference teachings of the 103 rejection.

extend communication range The Examiner also relies upon Cuckler in formulating the 103 rejection. Cuckler may not be properly combined with Wood nor MacLellan in support of the 103 rejection.

Cuckler is directed towards an *Intrusion Detecting System and Apparatus*. Non-analogous art areas cannot properly be combined for an obviousness rejection where the problems addressed by each are non-analogous from one another. *In re Deminski*, 230 USPQ 313, 315 (Fed. Cir. 1986.) A field of art is analogous *only* if one seeking the solution in one art area would be likely to seek the solution by referring to the other art. *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 225 USPQ 634 (Fed. Cir. 1985). Prior art references are only analogous if the reference is in the field of Applicant's endeavor or the reference is reasonably pertinent to the particular problem with which the inventor was concerned. M.P.E.P. §2141.01 (8th ed.) (citing *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992)). One concerned with RFID and tag communications would not look to a

reference concerned with intrusion detection for meaningful teachings. One of skill in the art addressing problems with respect to interrogation and transponder communication systems would not look to intrusion detection systems for meaningful teachings. The problems of Wood and MacLellan differ from the problems addressed by Cuckler and Cuckler is non-analogous art. The rejection of claim 1 is improper for at least this reason.

It is further alleged on page 7 of the Office Action that Cuckler teaches generating the forward link communication signal comprising a modulated signal for the purpose of extending the range of communication. Applicants disagree and submit the Cuckler generates the signal for intrusion detection and not for extending range as alleged. The Office Action cites no support for the allegation that Cuckler is concerned with or discloses expansion of range of communications. There is no motivation to combine the non-analogous teachings of Cuckler and the 103 rejection is improper for this additional reason.

As discussed above, there is no motivation to support the combination of teachings of MacLellan or Cuckler with the teachings of Wood. The Federal Circuit discussed proper motivation *In re Lee*, 61 USPQ 2d 1430 (Fed. Cir. 2002). The motivation identified in the Office Action is akin to the conclusory statements set forth in *In re Lee* which were found to fail to provide the requisite motivation to support an obviousness rejection. The Court in *In re Lee* stated the factual inquiry whether to combine references must be through and searching. It must be based on objective evidence of record. The Court in *In re Fritch*, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992) stated motivation is provided only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the

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references. The *Lee* Court stated that the Examiner's conclusory statements in the *Lee* case do not adequately address the issue of motivation to combine. The Court additionally stated that the factual question of motivation is material to patentability and can not be resolved on subjective belief and unknown authority. The Court also stated that deficiencies of cited references cannot be remedied by general conclusions about what is basic knowledge or common sense. The Court further stated that the determination of patentability must be based on evidence.

In the instant case, the record is entirely devoid of any evidence to support motivation to combine the teachings apart from the bald conclusory statements of the Examiner which are insufficient for proper motivation as set forth by the Federal Circuit. The Office cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims but must set forth rationale on which it relied. Statements set forth in the present Office Action are akin to the alleged motivation discussed *In re Lee* and accordingly are insufficient to combine the reference teachings. The 103 rejection of claim 1 is improper without the proper motivation and Applicant respectfully requests allowance of claim 1 in the next action.

According to the motivational rationale presented in the Office Action, any teachings of a secondary reference may be combined with the teachings of a primary reference if an improvement is provided. Applicant submits the *Lee* case clearly illustrates such an interpretation is improper, conclusory, and not in compliance with the M.P.E.P. for establishing a proper *prima facie* case of obviousness. The mere fact that references can be combined or modified does not render the resultant combination obvious *unless the*

prior art also suggests the desirability of the combination. M.P.E.P. §2143.01 *citing In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Page 3 of the Action alleges that MacLellan and Cuckler are combinable within the technological environment of the remote communication system. The mere fact that references can be combined or modified does not render the resulting combination obvious unless the prior art also suggests the desirability of the combination (or modification). M.P.E.P. §2143.01 (8th Edition) citing to *In re Mills* 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). There is no suggestion of the desirability of the combination in the prior art and the rejection of claim 1 is improper.

The Office Action relies upon an extension of range rationale in support of the combination of both MacLellan and Cuckler with Wood. The reliance is misplaced. Referring to col. 6, lines 39-42 of Wood, such teachings already clearly disclose adjusting power of interrogator 26 so that only devices within a certain range of interrogator 26 will respond. Accordingly, Wood already discloses sufficient ranging and adjustment of range teachings and one would not look to MacLellan or Cuckler for meaningful teachings. The Examiner has relied upon Applicants' disclosure in formulating the obviousness rejection using inappropriate hindsight reconstruction. There is no motivation to combine the reference teachings and at least some of the teachings relied upon are non-analogous art. The rejection of claim 1 is improper for at least the above numerous reasons.

In addition, claim 1 stands rejected over three references. The question under 35 U.S.C. §103 is not whether the differences between the prior art and the claims would have been obvious, but whether the claimed invention as a whole would have been obvious.

Stratoflex, Inc. vs. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871, 877 (Fed. Cir. 1983); M.P.E.P. §2141.02 (8th ed.). In *Schenck, A.G. vs. Nortron Corp.*, the court stated, Norton seeks to limit the focus of inquiry to a structural difference from the prior art and then to show that, that *alone* would have been obvious. That effort is not proper under the statute, which requires that an invention be considered 'as a whole,' 35 U.S.C. §103. *Schenck*, 713 F.2d 792, 218 USPQ 698, 700 (Fed. Cir. 1983); *see also Hybritech, Inc. vs. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ 81, 93 (Fed. Cir. 1986). To evaluate obviousness, a comparison must be made between the prior art as a whole and the claimed subject matter as a whole. *In re Langer and Haynes*, 465 F.2d 896, 175 USPQ 169, 171 (C.C.P.A. 1972). The fact that the Examiner combines so many references in his attempt to show that Applicant's claimed invention is "obvious" illustrates exactly why the invention is *not* obvious. There is simply nothing like, or suggestive, of Applicant's claim 1 invention in the prior art. The Examiner has searched and found small pieces of the claimed invention scattered amongst a combination three references with inapposite teachings. *A person of ordinary skill in the art would not combine the cited inapposite teachings.* Thus, the large number of cited references makes the Examiner's position tenuous in the extreme. The Examiner has not and cannot point to any "teaching, suggestion or motivation" in the prior art which supports the combination upon which he relies. Accordingly, the only plausible explanation for the combination cited by the Examiner is hindsight reconstruction. Specifically, the Examiner has impermissibly used Applicant's teaching to examine the prior art for the individually claimed elements, and then independently and mistakenly reached a conclusion of obviousness. Since the Examiner's

utilization of the numerous prior art references results from hindsight reconstruction rather than from teaching or suggestion in the prior art, the rejection of Claim 1 should be reversed.

The claims which depend from independent claim 1 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to the rejection of claim 3, the Office Action relies upon teachings of Wood as allegedly disclosing the claimed communication station including adjustment circuitry as set forth on page 7 of the Action. This statement is directly contrary to the statement on page 6 of the Action clearly stating Wood does not disclose a communication station.

In particular, it is alleged on page 7 of the Office Action that Wood discloses the communication station including the adjustment of the electrical characteristic of the forward link communication signal referring to the amplifier 79. The reliance of the Examiner upon the teachings of Wood with respect to reference 79 contradicts the statements on page 6 of the Action stating Wood does not disclose a communication station. Claim 3 recites the communication station includes adjustment circuitry. The reliance upon Wood is improper and inconsistent in view of the statements on page 6 of the Action. Limitations of claim 3 are not shown nor suggested by the prior art and claim 3 is allowable.

In addition, this contradictory statement is the antithesis of providing the requisite specificity mandated by the C.F.R. In particular, 37 C.F.R §1.104(c)(2) provides that *the pertinence of each reference, if not apparent, must be clearly explained and each rejected*

claim specified. Further, 37 C.F.R. §1.104(c)(2) states that the Examiner must cite the best references at their command. When a reference is complex or shows or describes inventions other than that claimed by Applicants, the particular teachings relied upon must be designated as nearly as practicable. The pertinence of each reference if not apparent must be clearly explained for each rejected claim specified. Applicants respectfully request clarification of the rejections with respect to specific references and specific references teachings therein pursuant to 37 C.F.R. §1.104(c)(2) in a **non-final Action** if claim 3 is not found to be allowable.

9 Claim 4 stands rejected over four references including Lomp. The rejection is in error. The teachings regarding the amplifier 79 of Wood are inapplicable inasmuch as claim 4 refers to the adjustment circuitry of the communication station and Wood is devoid of disclosing or suggesting a communication station as acknowledged in the Office Action. Further, the Examiner baldly alleges the combination of Lomp is appropriate because Lomp discloses AGC circuitry for the purpose of power control. There is no motivation for one of skill in the art to look to Lomp for power control teachings and the Examiner fails to provide **any basis** why one of skill in the art would look to Lomp for additional teachings. The Examiner using inappropriate hindsight reconstruction has combined Lomp with the other references of record. There is no motivation in support of the rejection of claim 4 and the rejection is in error.

19 In addition, Lomp is non-analogous art and was improperly relied upon in support of the rejection. Wood and MacLellan disclose RFID systems while Lomp is concerned with a Code Division Multiple Access (CDMA) communication system. One concerned with

RFID systems would not look to the disparate CDMA disclosure of Lomp for meaningful teachings. The rejection of claim 4 is improper for at least this additional reason.

Referring to claims 6 and 7, the Examiner on pages 7-8 again relies upon teachings of Wood as allegedly disclosing the power amplifier of the communication station. This reliance is contradictory to the statement of the Action that Wood fails to disclose or suggest the communication station. Claim 6 is allowable and Applicants request a non-final Action if claims 6-7 are not allowed.

Claim 9 stands rejected over Bassirat. The Examiner alleges the combination of four references including Bassirat is appropriate because Bassirat teaches a coaxial cable associated with the communication station for the purpose of extending the communication range. Applicants disagree. Applicants have searched and have failed to uncover any extension of communication range teachings in Bassirat as alleged. The Office Action fails to identify any teachings in Bassirat providing the alleged extension of communication range. Referring to the Abstract, Bassirat clearly proposes the use of the RF repeater to reduce effects of interference in a CDMA cell generated by an offending base station and is silent towards extension of range. There is no motivation to combine the disparate teachings of Bassirat with the other references of record and claim 9 is allowable for this additional reason.

Referring to claim 11, there is no motivation to combine the reference teachings. The 103 rejection of claim 11 is improper for at least this reason. Further, the prior art relied upon in support of the 103 rejection is non-analogous. The rejection is improper for this additional reason. Applicants request allowance of claim 11 in the next Action.

The claims which depend from independent claim 11 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 21, there is no motivation to combine the reference teachings. The 103 rejection of claim 21 is improper for at least this reason. Further, the prior art relied upon in support of the 103 rejection is non-analogous. The rejection is improper for this additional reason. Applicants request allowance of claim 21 in the next Action for at least these reasons.

The claims which depend from independent claim 21 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 26, there is no motivation to combine the reference teachings. The 103 rejection of claim 26 is improper for at least this reason. Further, the prior art relied upon in support of the 103 rejection is non-analogous. The rejection is improper for this additional reason. Applicants request allowance of claim 26 in the next Action.

Referring to claim 27, there is no motivation to combine the reference teachings. The 103 rejection of claim 27 is improper for at least this reason. Further, the prior art relied upon in support of the 103 rejection is non-analogous. The rejection is improper for this additional reason. Applicants request allowance of claim 27 in the next Action.

The claims which depend from independent claim 27 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 35, there is no motivation to combine the reference teachings. The 103 rejection of claim 35 is improper for at least this reason. Further, the prior art relied upon in support of the 103 rejection is non-analogous. The rejection is improper for this additional reason. Applicants request allowance of claim 35 in the next Action.

The claims which depend from independent claim 35 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 49, there is no motivation to combine the reference teachings. The 103 rejection of claim 49 is improper for at least this reason. Further, the prior art relied upon in support of the 103 rejection is non-analogous. The rejection is improper for this additional reason. Applicants request allowance of claim 49 in the next Action.

Referring to claim 50, there is no motivation to combine the reference teachings. The 103 rejection of claim 50 is improper for at least this reason. Further, the prior art relied upon in support of the 103 rejection is non-analogous. The rejection is improper for this additional reason. Applicants request allowance of claim 50 in the next Action.


Applicants hereby add new claims 51-57. Support for the new claims is found at least at Figs. 1 and 8 and the associated specification teachings of the originally-filed application.

Applicants respectfully request allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,

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